Attorney Docket No.: 9400-31 (030089) PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Harry Michael Schell
Serial No.: 10/627,110
Filed: July 25, 2003
For: METHODS AND COMPUTER PROGRAM PRODUCTS THAT CONDITIONALLY ROUTE PRINT FILES

Confirmation No.: 3761
Group Art Unit: 2176
Examiner: Laurie Anne Ries

December 2, 2008

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Commissioner for Patents
P.O. Box 1450
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APPELLANT'S AMENDED BRIEF ON APPEAL UNDER 37 C.F.R. §41.37

Sir:

This Amended Brief on Appeal is filed in response to the Notification of Non-Compliant Appeal Brief mailed November 13, 2008, and replaces Applicants' Amended Brief on Appeal filed September 18, 2007 in response to the "Notice of Appeal to the Board of Patent Appeals and Interferences" mailed June 22, 2007. Appellant has revised the Grounds of Rejection section to be consistent with the grounds of rejection listed in the Final Office Action of February 1, 2007, and has also revised the Argument section headings to match the headings of the Grounds of Rejection section.

REAL PARTY IN INTEREST

The real party in interest is assignee BellSouth Intellectual Property Corporation, now AT&T Intellectual Property, Inc., by name change recorded on June 14, 2007 at Reel 019426, Frame 0960.

RELATED APPEALS AND INTERFERENCES

Appellant is aware of no appeals or interferences that would be affected by the present appeal.

STATUS OF CLAIMS

Claims 2-10 and 12-21 remain pending as of the filing date of this Brief and stand finally rejected. Appellant appeals the final rejection of Claims 2-10 and 12-21 in the Final

Office Action. The attached Appendix A presents the claims at issue as finally rejected in the Final Office Action.

STATUS OF AMENDMENTS

Amendments filed January 12, 2006 and May 25, 2006 have been entered. No amendments have been filed after the Final Office Action. The attached Appendix A presents the pending claims and the corresponding status of each of the pending claims.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The present application includes independent Claims 6, 16, and 21.

Some embodiments of the present invention according to independent Claim 6 provide a method of routing print files in a computer system (e.g., 100 in Figure 1 and page 4, lines 7-10; 300 in Figure 3 and page 6, lines 4-8). The method includes evaluating content of at least one print file based on a routing policy (e.g., 200-222 in Figure 2 and page 4, lines 20-31; 114-116 in Figure 1 and page 5, lines 1-3, and 310-320 in Figure 3 and page 6, lines 4-12), where the print file is configured by an application for printing on a printer device (e.g., 136 in Figures 1 and 3 and page 5, lines 22-25). The print file is selectively routed (e.g., 200-230 in Figure 2 and page 5, lines 4-11, 18-22, line 29 - page 6, line 3) based on the evaluated content of the at least one print file to a non-printer device (e.g., 240 in Figure 2 and page 5, lines 25-28) instead of to a printer device (e.g., 136 in Figures 1 and 3 and page 5, lines 22-25) in response to the evaluated content of the print file.

Some embodiments of the present invention according to independent Claim 16 provide a computer program product for routing print files in a computer system (e.g., 100 in Figure 1 and page 4, lines 7-10; 300 in Figure 3 and page 6, lines 4-8). The computer program product includes program code embodied in a computer-readable storage medium. Program code evaluates content of at least one print file based on a routing policy (e.g., 200-222 in Figure 2 and page 4, lines 20-31; 114-116 in Figure 1 and page 5, lines 1-3, and 310-320 in Figure 3 and page 6, lines 4-12), where the print file is configured by an application for printing on a printer device (e.g., 136 in Figures 1 and 3 and page 5, lines 22-25). Further program code selectively routes (e.g., 200-230 in Figure 2 and page 5, lines 4-11, 18-22, line

29 - page 6, line 3) the print file based on the evaluated content of the at least one print file to a non-printer device (e.g., 240 in Figure 2 and page 5, lines 25-28) instead of to a printer device (e.g., 136 in Figures 1 and 3 and page 5, lines 22-25) in response to the evaluated content of the print file.

Some embodiments of the present invention according to independent Claim 21 provide a method of routing print files in a computer system (e.g., 100 in Figure 1 and page 4, lines 7-10; 300 in Figure 3 and page 6, lines 4-8). The method includes searching content of a print file to identify one or more keywords that are defined by a routing policy (e.g., 200-222 in Figure 2 and page 4, lines 20-31; 114-116 in Figure 1 and page 5, lines 1-3, and 310-320 in Figure 3 and page 6, lines 4-12), where the print file is configured by an application for printing on a printer device (e.g., 136 in Figures 1 and 3 and page 5, lines 22-25). The print file is selectively renamed (e.g., page 2, lines 1-6, and page 5, lines 18-28) based on identifying the one or more keywords (e.g., 200-222 in Figure 2 and page 4, lines 20-31; 114-116 in Figure 1 and page 5, lines 1-3, and 310-320 in Figure 3 and page 6, lines 4-12) in the print file instead of routing the print file to a printing device (e.g., 136 in Figures 1 and 3 and page 5, lines 22-25).

Some embodiments of the present invention according to dependent Claim 5 provide a further method of selectively routing the print file by renaming the print file based on the content of the print file and the routing policy (e.g., page 5, lines 5-9).

Some embodiments of the present invention according to dependent Claim 7 provide a further method of selectively routing the print file to a non-printer device (e.g., 240 in Figure 2 and page 5, lines 25-28) instead of to a printer device (e.g., 136 in Figures 1 and 3 and page 5, lines 22-25) in response to the evaluated content of the print file by posting the print file on a WEB page (e.g., page 5, lines 5-11).

Some embodiments of the present invention according to dependent Claim 9 provide a further method of selectively routing the print file by importing information from the print file into a spreadsheet application, a word processor application, and/or a database application (e.g., page 5, lines 11-17).

Some embodiments of the present invention according to dependent Claim 15 provide program code that selectively routes the print file by renaming the print file based on the content of the print file and the routing polic (e.g., page 5, lines 5-9).

Some embodiments of the present invention according to dependent Claim 17 provide program code that selectively routes the print file to a non-printer device (e.g., 240 in Figure 2 and page 5, lines 25-28) instead of to a printer device (e.g., 136 in Figures 1 and 3 and page 5, lines 22-25) in response to the evaluated content of the print file by posting the print file on a WEB page (e.g., page 5, lines 5-11).

Some embodiments of the present invention according to dependent Claim 19 provide program code that selectively routes the print file by importing information from the print file into a spreadsheet application, a word processor application, and/or a database application (e.g., page 5, lines 11-17).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether Claims 2-4, 6-7, 12-14, and 16-17 are properly rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2004/0001223 to Tanaka.

2. Whether Claims 5 and 15 are properly rejected under 35 U.S.C. § 103(a) as unpatentable over Tanaka in view of U.S. Patent Application Publication No. 2004/0083273 to Madison?

3. Whether Claims 9-10 and 19-20 are properly rejected under 35 U.S.C. § 103(a) as unpatentable over Tanaka in view of U.S. Patent No. 6,906,817 to Berard.

4. Whether Claim 21 is properly rejected under 35 U.S.C. § 103(a) as unpatentable over Berard in view of Tanaka and Madison.

ARGUMENT

All of the pending claims stand rejected as allegedly being obvious. To establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest all the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one

of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. §2143. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v. Teleflex Inc.*, 550 U. S. 1, 15 (2007). A corollary principle is that, when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be unobvious. *Id.* at 12. If a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Id.* at 13. A Court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.* at 13. When it is necessary for a Court to look at interrelated teachings of multiple patents, the Court must determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *Id.* at 14.

1. Claims 6, 7, 16, and 17 are patentable over Tanaka

Independent Claims 6 and 16:

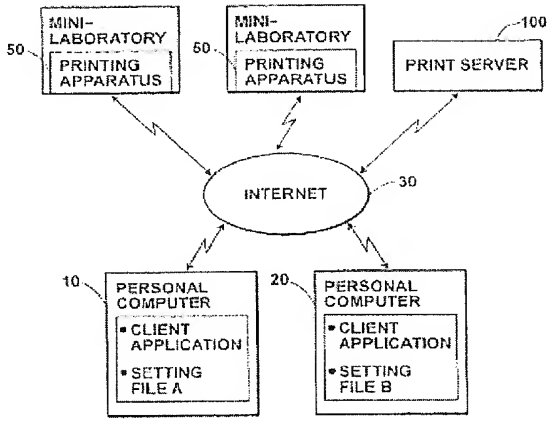
Independent Claim 6 recites (emphasis added):

> 6. A method of routing print files in a computer system, the method comprising:
> *evaluating content of at least one print file based on a routing policy, wherein the print file is configured by an application for printing on a printer device*; and
> *selectively routing* the print file based on the evaluated content of the at least one print file *to a non-printer device instead of to a printer device in response to the evaluated content of the print file.*

Accordingly, Claim 6 recites that the file whose content is evaluated based on a routing policy is a *print file* that is configured by an application for printing on a printer device. Furthermore, the *print file* is selectively routed to a non-printer device instead of to a printer device *in response to the evaluation of the content of the print file*.

Tanaka describes a personal computer (10) that has a client application and a separate setting file (A), and another personal computer (20) that has a client application and a separate setting file (B), as shown in FIG. 1 of Tanaka below.

FIG. 1 of Tanaka



The client applications and setting files (A), (B) are installed in the personal computer (10) from media (CDs) enclosed within "as *supplements of magazines A and B.*" (Tanaka, Para. 39). Tanaka describes the setting files (A),(B) as follows:

> The setting files A and B attached to the client applications respectively have information representing the name of the corresponding magazine as a distribution route, the name of a privilege service available to the client application, and an effective time period of the privilege service."
> (Tanaka, Para. 39).

Accordingly, the setting files (A),(B) identify from what magazine a client obtained the setting files (e.g., "distribution route" can be "magazine A" or "magazine B"), the type of service available to the client (e.g., "privilege service" can be the number of free print outs available), and an expiration date for the service. The client then separately supplies image files that the client wants to print using the services defined by the setting files.

Tanaka illustrates the printing process by the personal computers (10),(20) and print server (100) in FIGS. 4 and 5, below.

FIG. 4 of Tanaka

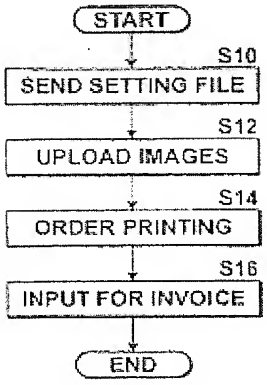
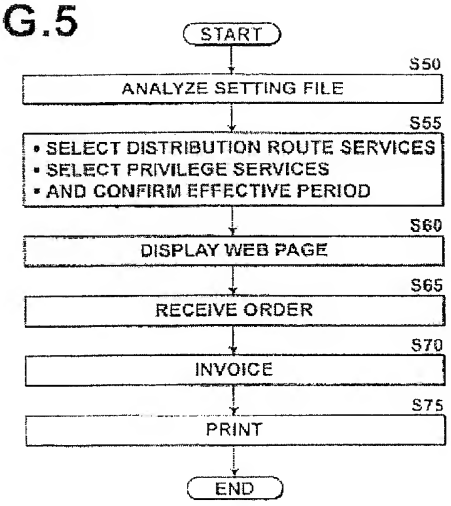


FIG. 5 of Tanaka

FIG.5



Tanaka describes that the personal computer 10 initially sends the magazine supplied setting file (A) (step S10) to the print server (100), where the setting file (A) defines the services that are available to the client (e.g., how many printouts are authorized) and an expiration date for the services. The personal computer (10) then separately uploads user supplied image files (step S12) to the print server (100). *The print server (100) analyzes the setting file (step S50) and, based on the settings in the setting file, prints the uploaded images (step S75) and generates an invoice for the printing (S70).* Accordingly, the image file is a print file because it is configured by the personal computer (10) for printing (step S75) by the

print server (100), while the *setting file (A) is not a print file because it is not configured to be printed and, indeed, it is not printed by the print server (100).*

In sharp contrast to Claim 6, Tanaka analyzes the contents of the setting file, not the contents of the separate image file which is to be printed. Nowhere does Tanaka describe or suggest *that the contents of the image file are evaluated or, much less, that the contents of the image file are evaluated based on a routing policy*.

Moreover, Tanaka does not describe or suggest *that the image file is selectively routed to a non-printer device instead of being printed by the print server (100) in response to evaluation of the content of the image file based on a routing policy*. Instead, Tanaka describes that the user supplied image file is either printed or discarded in response to the contents of the magazine supplied setting file.

For at least these reasons, Appellant submits that Claim 6 is patentable over Tanaka because Tanaka does not describe or suggest evaluating content of at least one print file based on a routing policy, and it does not describe or suggest selectively routing the print file, based on the evaluated content of the print file, to a non-printer device instead of to a printer device. Accordingly, a *prima facie* case of obviousness over Tanaka has not been made, and the rejection of Claim 6 under 35 USC §103(a) should be reversed.

Independent Claim 16 is a computer program product claim that includes recitations that correspond to those of Claim 6 and, consequently, is submitted to be patentable over Tanaka for at least the reasons explained with regard to Claim 6. For at least these reasons, Applicant submits that a *prima facie* case of obviousness over Tanaka has not been made, and Applicant requests that the rejection of Claim 16 under 35 USC §103(a) be reversed.

Dependent Claims 7 and 17:

Dependent Claims 7 and 17 recite that the print file is selectively posted on a WEB page, instead of being routed to a printer device for printing, based on evaluation of the print file and a routing policy.

As explained above, Tanaka describes that the image files uploaded to the print server (100) are printed (step S75 in FIG. 5). The Office Action refers to paragraph 44 of Tanaka which describes *that the setting file is analyzed* (step S50, FIG. 5) *to obtain information from*

the setting file that can be displayed on a WEB page (S60, FIG. 5) so as to query a client for instructions on how to print the uploaded image file (See Tanaka, FIG. 7). Tanaka does not describe or suggest that the print file itself can be selectively posted on a WEB page. Indeed, Tanaka teaches that two distinct and separate types of files are needed for operation, a setting file that is distributed with magazines and defines what printing services may be used by a particular user, and a separate image file that is uploaded by the user.

Neither the cited paragraph of Tanaka nor elsewhere does Tanaka describe or suggest that a print file is selectively posted on a WEB page instead of being sent to a printer device for printing in response to evaluation of the contents of the print file and a routing policy. Accordingly, a *prima facie* case of obviousness over Tanaka has not been made, and the rejection of Claims 7 and 17 under 35 USC §103(a) should be reversed.

2. Dependent Claims 5 and 15 are Independently Patentable Over Tanaka in view of Madison

Dependent Claims 5 and 15 recite that the print file is selectively renamed based on evaluation of the content of the print file and a routing policy. Accordingly, Claims 5 and 15 contain similar recitations to Claim 21 directed to selectively renaming a print file, and which are not disclosed or suggested by Tanaka and Madison for at least the reasons explained below for Claim 21. Accordingly, a *prima facie* case of obviousness over Tanaka in view of Madison has not been made, and the rejection of Claims 5 and 15 under 35 USC §103(a) should be reversed.

3. Dependent Claims 9 and 19 are Independently Patentable Over Tanaka in view of Berard

Dependent Claims 9 and 19 recite that information from the print file is selectively imported into a spreadsheet application, a word processor, and/or a database application instead of being routed to a printer device for printing *based on evaluation of the content of the print file and a routing policy.*

In rejecting Claims 9 and 19, the Office Action contends on page 7 that "Berard discloses sending information from the print file to a database application (See Berard, Column 8, lines 31-35)." However, the cited portion of Berard recites the following:

> (e) if the extracted data identifies the intended recipient for the document, then: (i) sending a query to a database containing destination information associated with a pre-defined set of recipients, the query identifying the recipient and requesting as a response a destination associated with the intended recipient, and (ii) upon receiving a response to the query, sending the document by electronic transmission to that destination.

Appellant submits that neither the above-cited portion nor elsewhere does Berard describe or suggest that *a print file is selectively imported* into a spreadsheet application, a word processor, and/or a database application instead of being routed to a printer device for printing *based on evaluation of the content of the print file and a routing policy*. Accordingly, a *prima facie* case of obviousness over Tanaka in view of Berard has not been made, and the rejection of Claims 9 and 19 under 35 USC §103(a) should be reversed.

4. Independent Claim 21 is Patentable Over Berard in view of Tanaka and Madison

Claim 21 recites (emphasis added):

> 21. A method of routing print files in a computer system, the method comprising:
> searching content of a print file to identify one or more keywords that are defined by a routing policy, wherein the print file is configured by an application for printing on a printer device; and
> selectively renaming the print file based on identifying the one or more keywords in the print file instead of routing the print file to a printing device.

Accordingly, Claim 21 recites that the print file is configured by an application for printing on a printing device, and that the *print file is selectively renamed based on identifying one or more keywords contained in the print file that are defined by a routing policy, instead of routing the print file to a printing device.*

In rejecting the subject matter of Claim 21, the Final Office Action on page 9 concedes that "Berard does not disclose expressly searching the content of the file to identify one or more keywords that are defined by a routing policy or selectively renaming the file

based on the identified keywords." In the an attempt to supply some of the missing recitations, the Final Office Action contends on page 8 that "Tanaka discloses searching the content of a file to identify keywords defining a routing policy for the file." However, as explained above, Tanaka analyzes the contents of a magazine supplied setting file (which is not printed), not the contents of a separate user supplied image file that is to be printed.

The Final Office Action also contends on page 8 that "Madison discloses renaming a file based upon the data within the file, such as XML data indicating a successful or unsuccessful file upload, and a routing policy, such as the value of the XML data updated according to the result of the upload attempt." Appellant acknowledges that Madison discloses that a file is selectively renamed based on whether it was successfully uploaded. However, nowhere does Madison appear to disclose that a file is selectively renamed in response to what that file contains, or, much less, that a print file is selectively renamed in response to identifying within the print file one or more keywords that are defined by a routing policy.

Accordingly, a *prima facie* case of obviousness over Berard in view of Tanaka and Madison has not been made, and the rejection of Claim 21 under 35 USC §103(a) should be reversed.

VII. Conclusion

In light of the above discussion, Appellant submits that the pending claims are directed to patentable subject matter and, therefore, requests reversal of the rejections of the claims and passing of the application to issue.

It is not believed that an extension of time and/or additional fee(s) are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned for under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to Deposit Account No. 50-0220.

Respectfully submitted,

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CERTIFICATION OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on December 2, 2008.

Susan E. Freedman
Date of Signature: December 2, 2008

APPENDIX A
Pending Claims U.S. Serial No. 10/627,110
Filed July 25, 2003

1. (Canceled).

2. (Previously Presented) The method of Claim 6, wherein evaluating content of at least one print file based on a routing policy comprises searching the content of the print file for one or more keywords that are defined by the routing policy.

3. (Previously Presented) The method of Claim 6, wherein evaluating content of at least one print file based on a routing policy comprises comparing the content of the print file to one or more data structures that are defined by the routing policy.

4. (Previously Presented) The method of Claim 6, further comprising providing a Windows initialization (INI) file that defines the routing policy, and wherein evaluating content of at least one print file based on a routing policy comprises comparing the content of the print file to the routing policy defined by the INI file.

5. (Previously Presented) The method of Claim 6, wherein selectively routing the print file comprises renaming the print file based on the content of the print file and the routing policy.

6. (Previously Presented) A method of routing print files in a computer system, the method comprising:

evaluating content of at least one print file based on a routing policy, wherein the print file is configured by an application for printing on a printer device; and

selectively routing the print file based on the evaluated content of the at least one print file to a non-printer device instead of to a printer device in response to the evaluated content of the print file.

7. (Previously Presented) The method of Claim 6, wherein selectively routing the print file to a non-printer device instead of to a printer device in response to the evaluated content of the print file comprises posting the print file on a WEB page.

8. (Previously Presented) The method of Claim 6, wherein selectively routing the print file comprises emailing the print file to one or more users on a computer network based on the content of the print file and the routing policy.

9. (Previously Presented) The method of Claim 6, wherein selectively routing the print file comprises importing information from the print file into a spreadsheet application, a word processor application, and/or a database application.

10. (Original) The method of Claim 9, wherein selectively routing the print file further comprises transferring information from the print file to known fields in a report that are defined by the routing policy.

11. (Canceled).

12. (Previously Presented) The computer program product according to Claim 16, wherein the program code for evaluating content of at least one print file comprises program code for searching the content of the print file for one or more keywords that are defined by the routing policy.

13. (Previously Presented) The computer program product according to Claim 16, wherein the program code for evaluating content of at least one print file comprises program code for comparing the content of the print file to one or more data structures that are defined by the routing policy.

14. (Previously Presented) The computer program product according to Claim 16, wherein the routing policy is defined by a Windows initialization (INI) file, and wherein the

program code for evaluating content of at least one print file comprises program code for comparing the content of the print file to the routing policy defined by the INI file.

15. (Previously Presented) The computer program product according to Claim 16, wherein the program code for selectively routing the print file comprises program code for renaming the print file based on the content of the print file and the routing policy.

16. (Previously Presented) A computer program product for routing print files in a computer system, the computer program product comprising program code embodied in a computer-readable storage medium, the computer program code comprising:

program code for evaluating content of at least one print file based on a routing policy, wherein the print file is configured by an application for printing on a printer device; and

program code for selectively routing the print file based on the evaluated content of the at least one print file to a non-printer device instead of to a printer device in response to the evaluated content of the print file.

17. (Previously Presented) The computer program product according to Claim 16, wherein the program code for selectively routing the print file to a non-printer device instead of to a printer device in response to the evaluated content of the print file comprises program code for posting the print file on a WEB page.

18. (Previously Presented) The computer program product according to Claim 16, wherein the program code for selectively routing the print file comprises program code for emailing the print file to one or more users on a computer network based on the content of the print file and the routing policy.

19. (Previously Presented) The computer program product according to Claim 16, wherein the program code for selectively routing the print file comprises program code for

importing information from the print file into a spreadsheet application, a word processor application, and/or a database application.

20. (Original) The computer program product according to Claim 19, wherein the program code for selectively routing the print file further comprises program code for transferring information from the print file to known fields in a report that are defined by the routing policy.

21. (Previously Presented) A method of routing print files in a computer system, the method comprising:

searching content of a print file to identify one or more keywords that are defined by a routing policy, wherein the print file is configured by an application for printing on a printer device; and

selectively renaming the print file based on identifying the one or more keywords in the print file instead of routing the print file to a printing device.

APPENDIX B – EVIDENCE APPENDIX

(NONE)

APPENDIX C – RELATED PROCEEDINGS

(NONE)